

Amendment and Response Under 37 C.F.R. 1.116

Applicant: Jerome D. Brown et al.

Serial No.: 10/672,166

Filed: September 26, 2003

Docket No.: 10387US01 (I201.180.101)

Title: TAPE REEL ASSEMBLY WITH RADIALLY SYMMETRIC DEFORMING TAPE WINDING SURFACE**REMARKS**

The following remarks are made in response to the Final Office Action mailed August 26, 2005. In the Final Office Action, claims 1-20 were rejected under 35 U.S.C. § 112, second paragraph. In addition, claims 1, 2, 5-9, 12-16, 19, and 20 were rejected under 35 U.S.C. § 102(a) as being anticipated by Zwettler et al., U.S. Patent No. 6,474,582 ("Zwettler"), claims 3, 4, and 18 were rejected under 35 U.S.C. § 102(a) as being anticipated by, or in the alternative under 35 U.S.C. § 103(a) as obvious, over Zwettler, and claims 10, 11, and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zwettler in view of Hiraguchi et al., U.S. Patent No. 6,736,345 ("Hiraguchi").

With this Response, claims 1, 12, 18, and 20 have been amended. Claims 1-20 remain pending in the application and are presented for consideration and allowance.

Claim Rejections under 35 U.S.C. § 112

In the Final Office Action, claims 1-20 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention. The Office Action takes the position at page 2, lines 6-10 that "not contiguous" is deemed to be an inaccurate description. The Examiner suggests the use of the language "end surfaces," which is noted with appreciation.

Based upon the Examiner's guidance, claims 1, 12, and 18 have been amended to recite an annular arm that defines opposing end surfaces, and that a web extending from a core and connecting to a top half of the annular arm is not contiguous with the end surfaces. This language is supported throughout the Specification, and in particular, at page 8, lines 13-16, and in FIG. 3. It is respectfully requested that the language of the amended claims be entered, as the language is adopted based upon the Examiner's suggestion (MPEP § 714.13), and the amended language should not necessitate a further search.

Applicant respectfully requests that the rejections to claims 1-20 under 35 U.S.C. § 112, second paragraph, as being indefinite be withdrawn.

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Title: TAPE REEL ASSEMBLY WITH RADIALY SYMMETRIC DEFORMING TAPE WINDING SURFACE**Claim Rejections under 35 U.S.C. §§ 102 and 103**

Claims 1, 2, 5-9, 12-16, 19, and 20 were rejected under 35 U.S.C. § 102(a) as being anticipated by Zwettler; claims 3, 4, and 18 were rejected under 35 U.S.C. § 102(a) as being anticipated by, or in the alternative under 35 U.S.C. § 103(a) as obvious, over Zwettler; and claims 10, 11, and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zwettler in view of Hiraguchi. However, it is respectfully submitted that Zwettler is not available as a 35 U.S.C. § 102(a) reference, such that the rejections to claims 1-20 based upon Zwettler must be withdrawn.

The Final Office Action at page 2, last paragraph asserts: "Zwettler et al discloses a tape cartridge having substantially all the claimed features including a core 62, annular arm 61, and web extending from the core at location 66 to the arm."

However, in an affidavit signed July 1, 2005, Affiant Jerome D. Brown states: "I collaborated in conceiving aspects of the hub design shown in FIG. 6 of Zwettler, and in particular, a ring or web 66 extending from a driving member or core 62 to an approximate mid-point of a cylinder or annular arm 61."

The Final Office Action takes the position at page 4, lines 4-6, that "in the Declaration, Applicant only stated that he collaborated in conceiving aspects of the hub design which suggest the involvement and contribution of others." The Examiner cites to MPEP § 2132.01 in asserting that a Section 1.132 Affidavit requires that an Applicant establish the claimed invention is his own work. Applicant respectfully disagrees, and notes that the collaborative efforts of the inventors does not negate the fact that Mr. Brown conceived certain particular aspects of the Zwettler hub design related to web 66.

Applicant Brown is a named co-inventor of Zwettler et al., U.S. Pat. No. 6,474,582 ("Zwettler") assigned to Imation Corp. A patented invention may be the work of two or more joint inventors. 35 U.S.C. § 116 (1994). In fact, inventors may apply for a patent jointly even though each did not make the same type or amount of contribution. § 116. Thus, collaborating joint inventors are recognized under United States patent law as contributing in varying degrees, and this collaboration does not diminish the fact that each joint inventor may have conceived one, or more than one, aspects of the invention.

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"Conception is the touchstone of inventorship," and each inventor is generally understood to have contributed to the conception of the invention. Burroughs Wellcome Co. v. Barr Lab., Inc., 40 F.3d 1223, 1227-28, 32 USPQ2d 1915, 1919 (Fed. Cir. 1994). With this in mind, the Zwettler patent names four joint inventors, including Applicant Brown, in recognition that inventors may apply for a patent jointly even though each did not make the same type or amount of contribution. With specificity, Applicant Brown avers in the Affidavit signed July 1, 2005 that he conceived aspects of the hub design shown in Zwettler Figure 6, and in particular, a ring or web 66 extending from a driving member or core 62 to an approximate mid-point of a cylinder or annular arm 61. This is the exact structure the Examiner has cited to in Zwettler in support of rejections under 35 U.S.C. § 102(a).

Thus, Applicant Brown is understood under 35 U.S.C. § 116 in light of Burroughs Wellcome Co. to have conceived some subject matter in Zwettler related to the hub. The affidavit of Jerome D. Brown dated July 1, 2005 clearly sets forth at least some of the aspects Applicant Brown conceived, namely the web extending from the core to the annular arm shown in Figure 6 of Zwettler. Based upon this, the affidavit of July 1, 2005 referencing collaboration is an accurate statement of joint inventorship, and clearly specifies the portions that Applicant Brown views as his conceptual contribution. Consequently, the affidavit of Applicant Brown signed on July 1, 2005 establishes that the hub design shown in Zwettler Figure 6 having a web extending from a driving member or core 62 to an approximate mid-point of cylinder or annular arm 61 is Applicant Brown's own work.

It is respectfully submitted that Zwettler, and in particular the structure of the tape reel assembly illustrated in FIG. 6, is not available as a 35 U.S.C. § 102(a) reference such that the rejections to claims 1, 2, 5-9, 12-16, 19, and 20 under 35 U.S.C. § 102(a), the rejections to claims 3, 4, and 18 under 35 U.S.C. § 102(a), or alternately under 35 U.S.C. § 103(a), and the rejections to claims 10, 11, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Zwettler in view Hiraguchi, must be withdrawn. With regard to the rejections to claims 10, 11 and 17, it is respectfully submitted that Zwettler is not available as a reference, and Hiraguchi fails to teach or suggest a web that is not contiguous with end surfaces of an annular arm.

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Title: TAPE REEL ASSEMBLY WITH RADially SYMMETRIC DEFORMING TAPE WINDING SURFACE**CONCLUSION**

In view of the above, Applicant respectfully submits that pending claims 1-20 recite patentable subject matter, are in form for allowance, and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-20 is respectfully requested.

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No fees are required under 37 C.F.R. 1.16(h)(i). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 50-0471.

The Examiner is invited to telephone the Applicant's representative to facilitate prosecution of this application. Inquiries regarding this Response should be directed to Eric D. Levinson at Telephone No. (651) 704-3604, Facsimile No. (612) 704-5951. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being transmitted via telefacsimile to Examiner John O. Nguyen of Group Art Unit 3654, Fax No. (571) 273-8300 on this 24 day of October, 2005.

By 

Name: Nick Baumann